| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/998,619 | 11/30/2001 | Gregory Conn | 3298/1H309US2 | 5770 |

31846     7590     09/24/2003

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| EXAMINER |
|---|
| LIU, SAMUEL W |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1653 | |

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| *Advisory Action* | Application No. | Applicant(s) |
|---|---|---|
| | 09/998,619 | CONN ET AL. |
| | Examiner | Art Unit | |
| | Samuel W Liu | 1653 | |

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

<u>PERIOD FOR REPLY</u> [check either a) or b)]

a) ☒ The period for reply expires *four* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

        NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): <u>the provisional rejection, obviousness type double patenting</u>.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☒ affidavit, b)☒ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

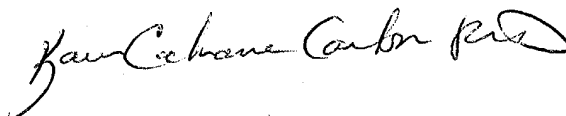    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: *1 and 3-9*.

    Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: The rejection under 35 USC 112, the second paragraph of the previous Office action mailed 15 May 2003 stands for the same reason set forth in the Office action.

Applicants' reply filed 27 August 2003 argues that the submitted Declaration of Phil Ropp supports applicant's assertion that the claims are clear as written (see page 7). The argument is unpersuasive. The Declaration is insufficient to overcome the rejection because the Declaration are directed to description of protecting sulfhydryl group for oxidation which has no input to the claimed method in view of patentability. The claims are directed to a method of preparing Troponin I protein. Without setting forth the step(s) as to how to prepare the protein thereof, solely reciting that method comprises protecting the sulfhydryl groups of the protein renders the claims indefinite since (i) the protection of sulfhydryl groups per se alone does not constitute the claimed method and insufficiently describe what actual step(s) of protection process is, and (ii) protecting the sulfhydryl groups of the protein can be a step of using the protein rather than making the protein thereof. Note that process of using and the process of making a protein is patentably distinct.

Applicants' reply has overcome the provisional rejection, obviousness type double patenting over the copending application NOs: 10287718 and 10255244 since the claims 1-9 and 13-20 of the both applications have been canceled by applicants. If enter, the rejections mentioned supra would be overcome.

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER